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Ans

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LY, NGHI H

ART UNIT PAPER NUMBER

2686

DATE MAILED: 06/25/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/504,875

Applicant(s)

NAKAJIMA, TOSHIKAZU

Examiner

Nghi H. Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 23, 28 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Valimaa et al (US 5,926,769).

Regarding claims 23 and 28, Valimaa teaches a method of operating a portable telephone having plural numbered dialing keys for dialing a telephone number (fig. 2, keypad 22, it is inherent that each key on the keypad represents a number, which has a unique identity, for dialing a telephone number), the method comprising the steps of: establishing the telephone in a call origination mode (see column 2, lines 56-58 and see column 4, lines 39-41), operating one of the plural numbered dialing keys and determining an identity of the operated one of the plural numbered dialing keys (column 4, lines 31-41, wherein a long depression of key number 5 recalls the telephone number

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stored at memory location 5), and changing from the call origination mode to an operating mode in which a call cannot be originated based on the determined identity of the operated one of the plural numbered dialing keys (see fig.3, step B, wherein long key depression changes from dialing mode to read/write mode, see column 2, lines 23-28 and see column 4, lines 32-41), wherein the step of changing from the call origination mode to an operating mode in which a call cannot be originated occurs when the determined identity of the operated one of the plural numbered dialing keys is one of a first set of the plural numbered dialing keys (fig.3, step B, wherein long key depression changes from dialing mode to read/write mode and see column 4, lines 32-41) and wherein the step of changing from the call origination mode to an operating mode in which a call cannot be originated does not occur when the determined identity of the operated one of the plural numbered dialing keys is one of second set of the plural numbered dialing keys that does not overlap the first set (fig.3, step B, wherein long key depression changes from dialing mode to read/write mode and see column 4, lines 32-41).

Regarding claim 29, Valimaa further teaches the processor (see system of Valimaa inherently includes a processor) performs a search of stored telephone numbers when a key in said first set of keys is operated (fig.3, step B, wherein long key depression changes from dialing mode to read/write mode and see column 4, lines 32-41).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 20-22 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valimaa et al (US 5,926,769) in view of Jang (US 5,280,516).

Regarding claims 20, 22, 25 and 27, Valimaa teaches a method of operating a portable telephone having plural numbered dialing keys that each have a unique identity for dialing a telephone number (fig. 2, keypad 22, It is inherent that each key on the keypad represents a number, which has a unique identity, for dialing a telephone number), the method comprising the steps of establishing the telephone in a call origination mode, operating one of the plural numbered dialing keys and determining the unique identity of the operated one of the plural numbered dialing keys (column 4, lines 31-41, wherein a long depression of key number 5 recalls the telephone number stored at memory location 5), changing from the call origination mode to an operating mode in which a call cannot be originated based on the determined unique identity of the operated one of the plural numbered dialing keys (fig.3, step B, wherein long key depression changes from dialing mode to read/write mode).

Valimaa does not specifically disclose *as soon as the unique identity of the operated one of the plural keys is determined* and changing from the call origination mode to an operating mode in which a call cannot be originated based on the determined unique identity of the operated one of the plural numbered dialing keys.

Jang teaches *as soon as the unique identity of the operated one of the plural keys is determined* (see column 1, lines 34-49 and see fig.2, step 202 and step 204), and changing from the call origination mode to an operating mode in which a call cannot be originated based on the determined unique identity of the operated one of the plural numbered dialing keys (also see column 1, lines 34-49 and see fig.2, step 202 and step 204).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Jang into the system of Valimaa in order to minimize the stress on the fingertip since the user does not have to press and hold the key.

Regarding claims 21 and 26, Valimaa further teaches the operating mode in which a call cannot be originated is a stored telephone number search mode (see Valimaa, fig.3, column 4, lines 31-41, wherein the Read Mode is to recall a stored telephone number).

6. Claims 24, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valimaa et al (US 5,926,769) in view of Giel et al (US 5,881,377).

Regarding claim 24, Valimaa teaches the method of claim 23. Valimaa does not specifically disclose the step of operating the two keys in the first set to perform a search of stored telephone numbers.

Giel teaches the step of operating the two keys in the first set to perform a search of stored telephone numbers (see fig.3, the first set (keys 110) includes one of the plural numbered dialing keys that are next to the other key, see numbered dialing key "0" is next to the keys "*" and "#", and see column 3, lines 43-48).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Giel into the system of Valimaa in order to maintain a secure hold of the communication device (see Giel, column 3, lines 53-57).

Regarding claims 30 and 31, Valimaa teaches claims 23 and 28. Valimaa does not specifically disclose the second set includes keys for "0" and "1" and the first set includes two of the plural numbered dialing keys that are next to each other.

Giel teaches the second set includes keys for "0" and "1" (see fig.3, the second set includes keys for "0" and "1") and the first set includes two of the one numbered dialing keys that are next to the other key (see fig.3, the first set includes one of the plural numbered dialing keys that are next to the other key, see numbered dialing key "0" is next to the keys "*" and "#", and see column 3, lines 43-48).

The combination of Valimaa and Giel does not specifically disclose the first set includes two of the plural numbered dialing keys that are next to each other.

However, those skilled in the art thus would appreciate that the teaching of Giel could be modified such that the first set includes two of the plural numbered dialing keys that are next to each other without changing the scope and spirit of Giel's invention.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Valimaa and Giel so that searching for the telephone numbers can be easier.

7. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valimaa et al (US 5,926,769) in view of Jang (US 5,280,516) and further in view of Giel et al (US 5,881,377).

Regarding claims 32 and 33, the combination of Valimaa and Jang teaches claims 22 and 25. The teaching of Valimaa and Jang does not specifically disclose the second set includes keys for "0" and "1" and the first set includes two of the plural numbered dialing keys that are next to each other.

Giel teaches the second set includes keys for "0" and "1" (see fig.3, the second set includes keys for "0" and "1") and the first set includes two of the one numbered dialing keys that are next to the other key (see fig.3, the first set includes one of the plural numbered dialing keys that are next to the other key, see numbered dialing key "0" is next to the keys "*" and "#", and see column 3, lines 43-48).

The combination of Valimaa, Jang and Giel does not specifically disclose the first set includes two of the plural numbered dialing keys that are next to each other.

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However, those skilled in the art thus would appreciate that the teaching of Giel could be modified such that the first set includes two of the plural numbered dialing keys that are next to each other without changing the scope and spirit of Giel's invention.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Valimaa, Jang and Giel so that searching for the telephone numbers can be easier.

Response to Arguments

8. Applicant's arguments with respect to claims 20-33 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (703) 605-5164. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly

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06/17/04


CHARLES APPIAH
PRIMARY EXAMINER